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Patent
Attorney Docket No. ITW7510.008

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Deonarine, Victor I.
Serial No. : 09/683,353
Filed : December 18, 2001
For : **DUAL TEMPERATURE INDICATOR STICK
HOLDER**
Group Art No. : 2859
Examiner : DeJesus, Lydia M.

CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10

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Lydia C. DeJesus
Signature

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF PURSUANT TO 37 C.F.R. §§1.191 AND 1.192

Dear Sir:

This Appeal Brief is being filed in furtherance to the Notice of Appeal mailed to the U.S. Patent & Trademark Office on December 22, 2003.

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1. REAL PARTY IN INTEREST

The real party in interest is Illinois Tool Works Inc., the Assignee of the above-referenced application by virtue of the Assignment to Illinois Tool Works Inc., recorded on February 26, 2002, recorded at reel 012424, frame 0212.

2. RELATED APPEALS AND INTERFERENCES

Appellant is unaware of any other appeals or interferences related to this Appeal. The undersigned is Appellant's legal representative in this Appeal. Illinois Tool Works Inc., the Assignee of the above-referenced application, as evidenced by the documents mentioned above, will be directly affected by the Board's decision in the pending appeal.

3. STATUS OF THE CLAIMS

Claims 1-20 are currently pending, and claims 1-20 are currently under final rejection and, thus, are the subject of this appeal.

4. STATUS OF AMENDMENTS

The Appellant has not submitted any amendments subsequent to the Final Office Action mailed on October 22, 2003.

5. SUMMARY OF THE INVENTION AND OF THE DISCLOSED EMBODIMENTS

Temperature indicator sticks are generally used in the welding, metal fabrication, and heat treatment industries to determine a surface temperature of the material being worked. *See: Application, paragraph [0002]*. Temperature indicator sticks are made of a material that melts at a given temperature, thereby leaving a residue on the material that has reached a given temperature as indicated by the temperature indicator stick. These sticks are typically positioned in a housing that includes an adjustable holder for repositioning the temperature indicator stick relative to the housing. *See: Application, paragraph [0003]*.

Some welding, or heat treating processes, require indication of multiple temperatures, thereby requiring multiple temperature indicator sticks to complete the task. *See: Application, paragraph [0006]*. Therefore, there is a need to separately fix multiple temperature indicator sticks in a single apparatus. *See: Application, paragraph [0007]*.

The present invention provides a temperature indicator assembly capable of indicating at least two temperatures. The temperature indicator assembly includes a first temperature indicator stick comprised of a compound which melts at a first temperature, and a second temperature indicator stick comprised of a compound which melts at a second temperature. The temperature indicator assembly physically connects the first temperature indicator stick and the second temperature indicator stick so that the assembly indicates both the first temperature and the second temperature. *See: Application, paragraph [0009].*

In accordance with one aspect of the present invention, a dual temperature indicator stick assembly has a first indicator stick housing positioned along a first axis and configured to hold a compound which melts at a first given temperature, and a second indicator stick housing positioned along a second axis and configured to hold a second compound which melts at a second given temperature. The dual temperature indicator stick assembly includes a one-piece connector physically connecting the first and second indicator stick housings along different axes. *See: Application, paragraph [0010].*

In accordance with another aspect of the present invention, a dual temperature indicator stick holder includes a connector assembly adapted to receive and position two temperature indicator sticks in a side-by-side relationship. The dual temperature indicator stick holder further includes a pair of advancement mechanisms configured to extend the two temperature indicator sticks from the connector assembly, wherein each of the pair of advancement mechanisms engages a respective temperature indicator stick upon rotation of a respective advancement mechanism. *See: Application, paragraph [0011].*

According to another aspect of the present invention, a dual temperature indicator stick apparatus has a first means for indicating a first temperature and a second means for indicating a second temperature. The apparatus further has means for retaining the first means to the second means in a side-by side relationship to form an indicator stick assembly capable of indicating at least two temperatures. *See Application, paragraph [0012].*

6. **ISSUES**

Issue No. 1:

Whether claims 1, 3-8, and 16-20 are anticipated under 35 U.S.C. §102(b) by OMEGAMARKER® Temperature Test Kit, hereinafter OMEGAMARKER®.

Issue No. 2:

Whether claims 2 and 10-15 are unpatentable under 35 U.S.C. §103(a) over OMEGAMARKER® in view of Tabachnik (USP 4,468,146).

Issue No. 3:

Whether claims 1 and 9 are unpatentable under 35 U.S.C. §103(a) over OMEGAMARKER® in view of Kirk (USP 3,564,668).

7. **GROUPING OF CLAIMS**

The Examiner has provided three grounds of rejection which Appellant contests. The claims of the groups do not stand or fall together.

8. **ARGUMENT**

As discussed in detail below, the Examiner has improperly rejected the pending claims. The Examiner has misapplied long-standing and binding legal precedents and principles in rejecting the claims under §§102(b) and 103(a) of Chapter 35 of the United States Code. Accordingly, Appellant respectfully requests full and favorable consideration by the Board as Appellant believes that claims 1-20 are currently in condition for allowance.

Issue No. 1:

The Examiner finally rejected claims 1, 3-8, and 16-20 as anticipated under 35 U.S.C. §102(b) by OMEGAMARKER®. The Examiner contends that OMEGAMARKER® teaches the dual temperature indicator stick assembly of the present invention. Appellant respectfully disagrees.

To anticipate a claim, the reference must teach each and every element of the claim. *See: MPEP §2131*. Appellant believes there are numerous distinctions between the current invention and the art cited by the Examiner, including the fact that OMEGAMARKER® does not form a dual temperature indicator stick. OMEGAMARKER® is a temperature test kit that includes a plurality of individual temperature indicating sticks. As the reference discloses, "the standard kit includes ten

individual temperature-sensitive crayons plus a holder for each crayon all in a self-contained case.” Emphasis added. That is, the reference itself discloses individual temperature-sensitive crayons disposed in a case and not a dual temperature indicator stick assembly. One of ordinary skill in the art will readily recognize that a plurality of individual temperature-sensitive crayons positioned in a case is not the same as, or equivalent to, a dual temperature indicator stick assembly as presently claimed.

In the response filed August 21, 2003, Appellant stated:

The Examiner’s application of the reference to the claims of the present application is tenuous at best and is not visible from the reference. It is apparent that the self-contained case of OMEGAMARKER® is intended as a storage device. It is equally apparent that the crayons, when located therein, don’t extend beyond a perimeter thereof. That is, the crayons are to be removed from the self-contained case when used to indicate any temperature, as evidenced by the three crayons in the foreground of the image. Additionally, the crayons must be contained within a perimeter of the self-contained case as the case, as is clearly shown, is intended to be closed thereby forming two layers of crayons, none of which are exposed. The Examiner is to interpret the claims in light of the Specification. As stated in the background of the present application, “Operators desiring to detect several temperatures must carry or locate multiple temperature indicators, which is often tedious.” The background further states that “It is difficult for an operator to hold a welding gun in one hand, for example, and two temperature indicator sticks in the other hand while wearing heat-resistant gloves.” This is the issue that is readily apparent from the OMEGAMARKER® reference even in light of the Examiner’s strained interpretation.

See: Response of 8/21/2003, page 6, paragraph 4 to page 7, paragraph 1.

Throughout prosecution of the present application, Appellant has argued that “case” cannot be equivalently considered a ‘connector’ as presently claimed. One skilled in the art will readily appreciate that “case” may be defined as “a container or receptacle.” American Heritage Dictionary, 2nd College Edition, p. 244 (copy attached). Notwithstanding the definition of “case”, the Examiner has, contrary to its plain meaning, determined “case” to be defined as a connector. However, “extrinsic evidence may be used to explain but not expand the meaning of terms and phrases used in the reference relied upon as anticipatory of the claimed subject matter.” (emphasis added) MPEP §2131.01(II), citing *In re Baxter Travenol Labs.*, 952 F.2d 388 (Fed. Cir. 1991). Accordingly, given the clear language of the OMEGAMARKER® reference, which explicitly identifies that which the Examiner is calling a “connector” as being a “self-

contained case”, it is improper for the Examiner to rely upon a definition that expands upon the meaning generally afforded and understood by one skilled in the art to the term “case”. Simply put, the OMEGAMARKER® reference defines the structure as a “case” and therefore any interpretation given by the Examiner must be consistent with and no broader than its generally considered meaning.

In short, the present invention is an improvement over that which is shown in OMEGAMARKER®. Nowhere in OMEGAMARKER® is it disclosed to connect two of the individual temperature-sensitive crayons into a single assembly capable of indicating a first temperature and a second temperature. As stated in the Background of the present invention, “many applications require two different temperature indicator sticks for testing different temperatures in a single operation. It is difficult for an operator to hold a welding gun in one hand, for example, and two temperature indicator sticks in the other hand while wearing heat-resistant gloves.” *See: Application, paragraph [0006].* The Examiner has applied the teaching of the present application to the OMEGAMARKER® reference in a strained effort to reject the present claims. A self-contained case cannot possibly be interpreted as a one-piece connector. A “connector” is not a “case” under any definition or within common usage.

Independent Claim 1

Regarding claim 1 in the Office Action of January 22, 2003, page 3, the Examiner contends that “OMEGAMARKER® discloses a dual temperature indicator stick assembly comprising...a one-piece connector physically connecting a first and a second indicator stick housing along different axis, the connector being the container case in which the indicator sticks are contained in a side-by-side relationship.” Appellant does not disagree that OMEGAMARKER® discloses a plurality of individual temperature-sensitive crayons disposed in a self-contained case. However, “the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach.” MPEP§2111, citing *In re Cartright*, 165 F3d 1353 (Fed. Cir. 1999). Accordingly, a person of ordinary skill in the art would not interpret the claimed one-piece connector physically connecting the first and second indicator sticks along different axis as equivalent to the self-contained case shown and described in the

OMEGAMARKER® reference. Further, as shown in the OMEGAMARKER® image, the indicator sticks removably contained within the case are certainly not positioned for use in such a position. As such, OMEGAMARKER® does not provide “a dual temperature indicator stick assembly”, as called for in claim 1. OMEGAMARKER® merely provides a plurality of individual temperature indicator sticks, each positioned in a case.

Appellant has strained to understand the Examiner’s position, but that position is simply not a reasonable one. As stated in the Response filed August 21, 2003, Appellant concedes that:

“A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art ...” MPEP §2123. Additionally, “drawings and pictures can anticipate claims if they **clearly show the structure** which is claimed. [Citation omitted] However, the picture must show all the claimed structural features and how they are put together. ... The drawings must be evaluated for what they reasonably disclose and suggest to one of ordinary skill in the art.” MPEP §2125 (emphasis added). The self-contained case of the OMEGAMARKER® reference is not an indicator stick assembly as stated in claim 1 nor would a person of ordinary skill in the art interpret it as such. It is a case to store temperature indicator sticks -- not a connector forming a part of an indicator stick assembly as called for in claims 1 and 10. A person of ordinary skill in the art would also readily recognize that the container case of OMEGAMARKER® is not an indicator stick assembly capable of indicating at least two temperatures. The Examiner’s conclusion that such is shown therein is beyond a reasonable interpretation of the figure. As an example, in order for this interpretation to be workable, one would need to insert hot metal into the case to indicate a temperature. A person of ordinary skill in the art would readily appreciate, from looking at the container case of OMEGAMARKER®, that inserting hot metal into the case would severely damage, if not destroy, the case itself. Accordingly, the Examiner’s interpretation is simply not a reasonable one.

See: Response of 8/21/2003, page 7, paragraph 3.

In addition to the foregoing, “[a] claim preamble must be read in the context of the entire claim” and “[a]ny terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation”. MPEP §2111.02 The preamble of claim 1 calls for a dual temperature indicator stick assembly. When the individual temperature indicator crayons of OMEGAMARKER® are disposed in the self-contained

case, they are not used to indicate any temperature. That is, in order for the individual indicators to indicate a temperature, they must be removed from the self-contained case. It is clear from the plurality of individual temperature indicating crayons in the foreground of the image that the temperature indicators are to be removed from the self-contained case for use. As such, it is not the assembly that indicates any temperature but merely the individual temperature-sensitive crayons removed therefrom. Even then, the individual temperature-sensitive indicator sticks each indicate only one temperature.

The Examiner has predicated the rejection upon erroneous and unsupported conclusions. By reiterating claim language and providing a strained interpretation of what is shown in OMEGAMARKER®, the Examiner has not only removed OMEGAMARKER® from its context and purpose to construct an unsupported rejection, the Examiner is interrupting the claims beyond that which is reasonable.

For all of the reasons stated above, Appellant believes claim 1 is clearly patentably distinct over the cited reference. Appellant believes claims 2-9 are in condition for allowance at least pursuant to the chain of dependency. However, since Appellant believes claims 4, 5, 6, and 7 include subject matter that is additionally distinguishable from the art of record, Appellant will specifically address that which is patentably distinct above and beyond the allowability of the claims pursuant to the chain of dependency.

Claims Dependent on Claim 1

In rejecting claims 3-9 under 35 U.S.C. §102(b) over OMEGAMARKER®, the Examiner states that:

The OMEGAMARKER® also includes in the connector/container case ribs for holding the indicator sticks in position, each of said ribs considered to be longitudinal member having curved ends with hooks configured to secure the first and second indicator stick housings to the connector/container case and to prevent rotation of the first and second indicator stick housings. The curved ends have a curved section on each side to said first and second indicator stick housings. The first and second indicator stick housings have an exterior surface having a groove therein for engaging the hooks of the curved ends of the longitudinal member, in this case the crayon holders include a surface with ribs that engage with the hooks at the ends of the longitudinal members/ribs in the connector/container case. It appears that said connector/container case is

configured to snap fit the first and second indicator stick housings to the connector/container case.

See: Office Action of 10/22/2003, page 3, paragraph 3 to page 4, paragraph 1.

Appellant does not necessarily disagree that the individual temperature-sensitive crayons of OMEGAMARKER® are received in individual channels formed in the self-contained case. However, that is not what is called for in claims 3-9 as rejected by the Examiner. At best, it appears that the self-contained case of OMEGAMARKER® includes a plurality of channels, each constructed to receive an individual, temperature-sensitive crayon therein. Claim 3 requires that the connector have a longitudinal member having curved ends, with the curved ends configured to secure the first and second indicator stick housings to the connector. There is no disclosure in OMEGAMARKER® to anticipate these limitations.

Claim 4 calls for, in part, a longitudinal member having curved ends “wherein the curved ends have hooks configured to engage the first and second indicator stick housings to prevent rotation of the first and second indicator stick housing.” The Examiner states, “in this case the crayon holders include a surface with ribs that engage with the hooks at the ends of the longitudinal members/ribs in the connector/container case.” *Id.* There is no disclosure in OMEGAMARKER®, in either the text or the image, that there are hooks formed at the ends of the longitudinal members. Additionally, under the Examiner’s interpretation, Appellant is unclear how the ribbed surface of the crayon holders would prevent the rotation of the first and second indicator sticks. Simply, it appears the individual temperature-sensitive crayons of OMEGAMARKER® are merely secured in the self-contained case but are not prevented from rotating once positioned therein. Appellant does not necessarily disagree that the container case engages the temperature stick housings in a snap-fit relation, as called for in claim 4; however, the conclusion that this relationship prevents rotation of the indicator sticks is not supported by the figure. It is clearly apparent that the indicator sticks are rotatable within the channels of the self-contained case by the orientation of the radial grooves on the indicator stick housings. It is equally apparent that each holder for each of the individual temperature-sensitive crayons is not restricted from rotating by any engagement between

the indicator stick housings and the self-contained case. As such, that which is called for in claim 4 is not disclosed, taught, or suggested in OMEGAMARKER®. Therefore, claim 4 contains subject matter that is patentable, independent from that of claim 1.

Regarding claim 5, claim 5 calls for, in part, that each of the curved ends, configured to secure the first and the second indicator stick housings to the connector, includes a pair of curved sections. The Examiner contends that the ends of the vertical ribs of the self-contained case each have a curved end and each curved end has a curved section on each side with a first section facing a first indicator holder and a second section facing the second indicator holder. *See: Office Action of 10/22/2003, page 3, paragraph 3.* If such is the case, the curved ends of OMEGAMARKER® are not configured to secure the indicator stick housings to the self-contained case. That is, under such an interpretation it is not the curved ends that secure the temperature indicator stick holder to the self-contained case but the cooperation of adjacent ends. A first curved end having a first and a second curved section is disposed a distance away from a second curved end also having a first and a second curved section. Each individual temperature-sensitive crayon is disposed in the gap formed by the distance between a curved section of the first curved end and a curved section of the second curved end. As such, it takes two curved ends to secure one temperature-sensitive crayon to the self-contained container. That is not what is called for in claim 5. Claim 5 calls for each curved end to have a pair of curved sections and is configured to secure the first and second indicator stick housings to the connector. The self-contained case of OMEGAMARKER® requires two curved ends to secure one temperature-sensitive crayon in the self-contained case. As such, that which is called for in claim 5 is not disclosed, taught, or suggested in OMEGAMARKER®. Therefore, Appellant contends claim 5 contains subject matter that is patentable, in addition to that of claim 1.

With respect to claim 6, claim 6 calls for, in part, that the connector slidingly secures the first and second indicator stick housings in a side-by-side relationship. It is apparent from the image of OMEGAMARKER® that the individual temperature-sensitive crayons located in their respective holders are not slidable when positioned in a channel formed in the self-contained case. That is, the individual temperature-sensitive

indicators are secured within the respective channels formed in the self-contained case and are not slidably secured therein. It is apparent that the self-contained case has walls at the end of each respective channel and these walls prevent the individual temperature-sensitive crayons from being slidably related to the self-contained case. As such, that which is called for in claim 6 is not disclosed, taught, or suggested in OMEGAMARKER®. Therefore, Appellant contends claim 6 contains subject matter that is patentable, in addition to that of claim 1.

Claim 7 calls for, in part, that the “first and second indicator stick housings have an exterior surface having a groove therein for engaging the hooks of the curved ends of the longitudinal member.” That is, it is the groove formed in the housing that engages the hooks of the curved ends, not merely the housing. There is no structure shown or disclosed in OMEGAMARKER® that engages the “grooves” formed between the ribs of the holders. At best, it appears that the tips of the ribs are constructed to be received in the individual channels formed in the self-contained case so that the individual temperature indicating crayons do not fall out of the self-contained case. That is, each individual temperature-sensitive crayon appears to be snap-fitted into each respective channel of the case. That is not what is called for in claim 7. Claim 7 calls for a groove in the exterior surface of the housing for engaging the hooks of the curved ends. Such is not shown or disclosed in OMEGAMARKER®. As such, Appellant contends claim 7 contains subject matter that is patentable, in addition to that of claim 1.

Independent Claim 16

In the Office Action of October 22, 2003, the Examiner rejected claims 16-20 under 35 U.S.C. §102(b) over OMEGAMARKER® stating that “OMEGAMARKER® discloses a dual temperature indicator stick apparatus comprising a first means for indicating a first temperature ..., a second means for indicating a second temperature ..., and means for retaining the first means to the second means in a side-by-side relationship to form an indicator stick assembly capable of indicating at least two temperatures, in this case a container case.” *See: Office Action of 10/22/2003, page 4, paragraph 2.*

Appellant does not necessary disagree that OMEGAMARKER® shows a plurality of individual temperature-sensitive crayons each having a holder removably

positionable in a self-contained case. Claim 16 calls for, in part, "means for retaining the first means to the second means in a side-by-side relationship to form an indicator stick assembly capable of indicating at least two temperatures." Such means is not shown in OMEGAMARKER®.

The Examiner's interpretation of OMEGAMARKER®, in order to show, teach, or disclose this element of claim 16, would require a person to insert hot metal into the case to indicate one of at least two temperatures. Such an interpretation would not only damage, if not destroy the self-contained case, but is also a far cry from its intended use as a storage container. Accordingly, the Examiner's interpretation is simply not a reasonable one.

At least for the reasons stated above, Appellant believes claim 16 is patentably distinct over the cited reference. Furthermore, Appellant believes claims 17-20 are in condition for allowance at least pursuant to the chain of dependency.

Conclusion of Issue No. 1:

Claims 1, 4-7, and 16 are patentably distinct over OMEGAMARKER®. The Examiner has based the rejection upon a misuse of terminology, ignored claim elements, and removed the claim elements from the context of the claim. As such, the Examiner has maintained the rejection with citations that are not supported by the reference. OMEGAMARKER® does not teach each and every element of the claimed invention as required. Therefore, since claims 1, 4-7, and 16 are not anticipated by OMEGAMARKER® and are believed to be patentably distinct over the art of record, and claims 3, 8, and 17-20 depend therefrom, Appellant respectfully requests allowance of claims 1, 3-8, and 16-20.

Issue No. 2:

The Examiner rejected claims 2 and 10-15 under 35 U.S.C. §103(a) over OMEGAMARKER® in view of Tabachnik (USP 4,468,146). The Examiner provided no actual citation to the body of Tabachnik but merely applied the terminology of the present application to the part numbers and figures of Tabachnik. Additionally, in addressing four pages of argument in support of patentability, the Examiner merely states that "Applicant's arguments filed August 21, 2003 have been fully considered but they are not

persuasive. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. [citation omitted]" *See: Office Action of 10/22/2003, page 7, paragraph 5 to page 8, paragraph 1.* The Examiner has disregarded the distinctions presented.

Independent Claim 10

In response to the Examiner's rejection of claim 10, Appellant stated:

Claims 2 and 10, in part, call for a dual temperature indicator stick assembly having a pair of advancement mechanisms configured to extend the two temperature indicator sticks from a connector wherein each of advancement mechanisms engage a respective temperature indicator stick.

Tabachnik shows a single advancement mechanism wholly contained within a crayon holder. There is no teaching in Tabachnik for the connection of two such crayon holders nor is there any teaching in Tabachnik for **a pair** of resistance mechanisms or **a pair** of collets. Additionally, due to the decorative nature of the Tabachnik holder 10, having two such crayon holders connected is not only implausible but beyond any teaching contained therein.

See: Response of 8/21/2003, page 8, paragraph 4 to page 9, paragraph 1.

Claim 10 calls for in part, "a connector assembly adapted to receive and position two temperature indicator sticks in a side-by-side relationship and a pair of advancement mechanisms configured to extend the two temperature indicator sticks from the connector assembly." The Examiner has applied OMEGAMARKER® similarly as to claim 1, but has incorporated the mobility of the writing instrument of Tabachnik to meet the limitations of claim 10. The Examiner states that:

[I]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the first and second indicator stick housing of OMEGAMARKER® to each include a pair of resistance mechanisms [46] to limit rotational movement of the corresponding indication stick, a collet [38] rotatably coupled to the housing, said collet having threads [42], and wherein said collet is configured to engage a corresponding indicator stick upon rotation of the collet about the axis of the housing, as taught by Tabachnik, in order to control the length of protrusion of the indicator stick

See: Office Action of 10/22/2003, page 5, paragraph 4.

Even if the advancement mechanism of Tabachnik were incorporated into the holders of the temperature indicator sticks of OMEGAMARKER®, such indicator sticks are still not extendable from the self-contained case of OMEGAMARKER®. That is, a

reasonable combination of these references, without using improper hindsight of the present application, would result in a plurality of individually extendable temperature indicators stored in a self-contained case. No reasonable combination of these two references would provide a dual temperature indicator stick assembly as claimed. Simply, the individual markers of OMEGAMARKER®, even if combined with the adjustability of Tabachnik, are still individual temperature indicators and are not extendable beyond the self-contained case when the indicators are positioned therein. Further, if the individual temperature indicators are removed to allow extension of the “two temperature indicator sticks from the connector assembly”, then there is no “connector assembly adapted to receive and position two temperature indicator sticks in a side-by-side relationship”, as called for in claim 10.

A person of ordinary skill in the art would recognize OMEGAMARKER® for what it is – a plurality of individual temperature indicators combined in a self-contained case. Combining it with Tabachnik does not form a dual temperature indicator stick holder as claimed. At best, it forms a plurality of individual temperature indicator sticks in a case.

Additionally, the combination of the writing instrument holder of Tabachnik with the temperature indicators of OMEGAMARKER® would not only prevent the holders from snap-fitting in the channels formed in the self-contained case, but the holders would not need to be adjustable because, as shown in OMEGAMARKER®, the exposed end of the indicators is restricted along the axis of the indicators by the self-contained case.

Further, Appellant questions whether there is a motivation for one skilled in the welding art to combine the temperature indicators of OMEGAMARKER® that are stated as having typical applications that include “lab use, forging, heat treating and fabrication of metals, molding of rubber and plastics, and general purpose use on any accessible heated surface” with the toy crayon holder of Tabachnik that illustrates a nutcracker-like wooden soldier crayon holder. Appellant believes that a motivation to combine these references is lacking, and the Examiner has not provided a sufficient basis to combine these references.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. MPEP §2142. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes each and every element of the claimed invention, but also provide "a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). That is, "[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP § 2143.01. "The fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness." Id. When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

As such, that which is called for in claim 10 is patentably distinct over OMEGAMARKER® singly, or in combination with Tabachnik. Furthermore, Appellant believes claims 11-15 are in condition for allowance at least pursuant to the chain of dependency.

Conclusion of Issue No. 2:

Claim 10 is patentably distinct over OMEGAMARKER® in view of Tabachnik. The Examiner has based the rejection upon a misunderstanding of terminology, ignored claim elements, and removed the claim elements from the context of the claim. OMEGAMARKER® in view of Tabachnik does not teach each and every element of the rejected claim. Further, there is no motivation to combine these references in a way

proposed by the Examiner. Therefore, since claim 10 is patentably distinct over the art of record, and claims 11-15 depend therefrom, Appellant respectfully requests allowance of claims 10-15 over OMEGAMARKER® in view of Tabachnik.

Issue No. 3:

The Examiner rejected claims 1 and 9 under 35 U.S.C. §103(a) over OMEGAMARKER® in view of Kirk (USP 3,564,668).

Independent Claim 1

The Examiner rejected claim 1 under 35 U.S.C. §103(a) over OMEGAMARKER® in view of Kirk applying only OMEGAMARKER® to the elements of claim 1 similar to the rejection addressed in issue 1.

It is apparent, and would be apparent to a person of ordinary skill in the art, that the individual temperature-sensitive crayons of OMEGAMARKER® are to be removed from the self-contained case during use. There is no disclosure, teaching, or suggestion in OMEGAMARKER® to connect at least two of the temperature-sensitive crayons with a connector to form a dual temperature indicator stick assembly as called for in claim 1. It is equally apparent that the Examiner has used the teaching of the specification of the present application as an instruction book in interpreting the art of record. That is, without the benefit of the hindsight of the specification of the present application, which outlines the benefits and reasons for combining two temperature indicators into a single assembly, there is no disclosure, suggestion, or motivation to connect two of the individual temperature-sensitive crayons of OMEGAMARKER® to form the dual temperature indicator stick assembly/holder of the present invention. Therefore, at least for those reasons argued above, claim 1, and those claims that depend therefrom, are patentably distinct over the art of record. Furthermore, irrespective of the appropriateness of rejecting a single element of a claim, Appellant believes it has previously shown that claim 1 is patentably distinct from OMEGAMARKER®. The inclusion of Kirk does not overcome this showing and it is respectfully asserted that claims 1 and 9, as a whole, are patentably distinct as well.

Dependent Claims

Claim 9 depends from a claim that Appellant has previously shown patentably distinct from the art of record. As such, Appellant believes claim 9 is in condition for allowance at least pursuant to the chain of dependency.

Conclusion of Issue No. 3:

The Examiner rejected claims 1 and 9 as unpatentable under 35 U.S.C. § 103(a) over OMEGAMARKER® in view of Kirk. Claims 1 and 9 are patentably distinct over OMEGAMARKER® in view of Kirk. The Examiner has based the rejection upon a misunderstanding of terminology, failed to address claim elements, and removed claim elements from the context of the claim. The Examiner has not shown any motivation to combine the references, other than Appellant's own application. As such, the Examiner has not made a *prima facie* case of obviousness and has maintained the rejection with citations that are unsupportive. Simply, the combination of OMEGAMARKER® and Kirk does not teach each and every element of the claimed invention. Therefore, since claim 1 is patentably distinct over the art of record, and claim 9 depends therefrom, Appellant respectfully requests allowance of claims 1 and 9 over OMEGAMARKER® in view of Kirk.

9. CONCLUSION

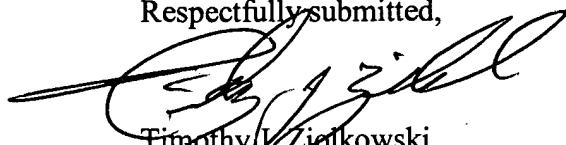
In view of the above remarks, Appellant respectfully submits that the Examiner has provided no supportable position or evidence that claims 1, 4-7, and 16 are anticipated under 35 U.S.C. §102(b) and claims 1 and 10 are obvious under 35 U.S.C. §103(a). Regarding the rejections of claims 2, 3, 8, 9, 11-15, and 17-20, as these claims depend from claims that are patentably distinct over the art of record, Appellant believes these claims are patentable at least through the chain of dependency. Accordingly, Appellant respectfully requests that the Board find claims 1-20 patentable over the prior art of record, direct withdrawal of all outstanding rejections and direct the present application be passed to issuance.

General Authorization for Extension of Time

In accordance with 37 C.F.R. §1.136, Appellant hereby provides a general authorization to treat this and any future reply requiring an extension of time as

incorporating a request therefore. A Credit Card Authorization is included for the \$320.00 fee for filing this Appeal Brief Under 37 C.F.R. §1.17(c).

Respectfully submitted,



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Dated: February 23, 2004
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expressing the names or epithets of royal or divine personages. 3. *Obs.* A heavy paper cartridge case. [Fr. < Ital. *cartoccio* < *carta*, card. —see CARTON.]

cartridge (kär'trij) *n.* 1. *a.* A tubular metal or cardboard and metal case containing the propellant powder and primer of small arms ammunition or shotgun shells. *b.* Such a case fitted with a projectile, such as a bullet. 2. A small modular unit of equipment designed to be inserted into a larger piece of equipment. 3. A removable case containing the stylus and electric conversion circuitry in a phonograph pickup. 4. A case containing reeled magnetic tape, a pickup reel, and guide and feed mechanisms, used instead of separate reels in certain tape recorders and players. 5. A case with photographic film that can be loaded directly into a camera. [Earlier *cartage*, var. of Fr. *cartouche*. —see CARTOUCHE.]

cartridge belt *n.* A belt with loops or pockets for carrying ammunition or other kinds of equipment.

cartridge clip *n.* A metal container or frame for holding cartridges to be loaded into an automatic rifle or pistol.

cartulary also **chartulary** (kär'tchä-lär'ē) *n.*, *pl.* -ies. A collection of deeds or charters, esp. a register of titles to all the property of an estate or monastery. [Med. Lat. *cartularium* < Lat. *cartula*, dim. of *carta*, leaf of papyrus. —see CARD.]

cartwheel (kär'thwél', -wél') *n.* 1. A somersault or hand-spring in which the body turns over sideways with the arms and legs spread like the spokes of a wheel. 2. *Slang.* A silver dollar or other large coin.

caruncle (kär'üng'käl, kär'üng') *n.* 1. A fleshy, naked outgrowth, such as a fowl's wattles. 2. *Bot.* An excrescence on a seed at or near the hilum. [Obs. Fr. *caruncule* < Lat. *caruncula*, dim. of *caro*, flesh.] —*carun'cu-lar* (-lär') *adj.* —*carun'cu-late* (-lit, -lät'), *carun'cu-lat-ed* (-lit'd) *adj.*

carva-crol (kär'və-krol', -krōl') *n.* A liquid phenol, $C_{10}H_{14}O$, used in flavorings and fungicides. [NLat. *carvi*, specific epithet of *Carum carvi*, caraway + Lat. *acer*, acer, sharp + -ol.]

carve (kärv) *v.* *carved*, *carving*, *carves*. —*tr. v.* 1. *a.* To divide into pieces by cutting; slice: *carve a turkey*. *b.* To divide by parceling out: *carve up an estate*. 2. To cut into a desired shape; fashion by cutting: *carve the wood into a figure*. 3. To make or form by or as if by cutting: *carve initials in the bark*; *carved out an empire*. 4. To decorate by carving. —*intr.* 1. To engrave or cut figures as a hobby or trade. 2. To disjoint, slice, and serve meat or poultry. [ME *kerven* < OE *ceorfan*.] —*carver n.*

carvel (kär'vel, -vél') *n.* Variant of caravel.

carvel-built (kär'vel-bült', -vél'-) *adj.* Built with the hull planks lying flush or edge to edge rather than overlapping: *a carvel-built ship*.

carven (kär'ven) *v.* *Archaic.* Past tense and past participle of *carve*.

carving (kär'veng) *n.* 1. The cutting of wood, stone, or other material to form a figure or design. 2. The figure or design formed by carving.

car wash *n.* An area or a building equipped for washing cars.

car-yat-id (kär'ë-ä'tid) *n.*, *pl.* -ids or -ides (-i-dëz'). *Archit.* A supporting column sculptured in the form of a woman. [< Lat. *Caryatides*, caryatids, maidens of Caryae < Gk. *Karyatides* < *Karuai*, Caryae, a village in Greece.] —*car'yat-id* (-i-dël), *car'yat-id-ean* (-i-dë'n), *car'yat-id'ic* (-i-dë'ik) *adj.*

car-yo- *pref.* Variant of *karyo-*.

car-yop-sis (kär'ë-öp'sës) *n.*, *pl.* -*op-ses* (-öp'sëz) or -*op-si-des* (-öp'së-dëz). A one-celled, one-seeded dry fruit having its outer coat fused to its surface, as a grain of barley or wheat. [CARY(O) + -OPSI-]

cas-a-ba also **cas-sa-ba** (kä-sä'bä) *n.* A variety of winter melon having a yellow rind and sweet, whitish flesh. [After *Kasaba*, former name for Turgutlu, Turkey.]

Cas-a-no-va (kä'sä-nö'və, käz'-) *n.* A promiscuous and unscrupulous man; libertine. [After G.J. Casanova de Seingalt (1725-1798).]

cas-sarva (kä-sä'rva) *n.* Variant of cassava.

Cas-bah (käz'bä, käz'-) *n.* 1. In northern Africa, the citadel and palace of a sovereign. 2. The native quarter in any of several cities in northern Africa. [Fr. < dial. Ar. *qasbah* < Ar. *qasabah*, fortress.]

cas-cade (kä-skäd') *n.* 1. A waterfall or a series of small waterfalls over steep rocks. 2. Something resembling a cascade, esp. an arrangement or fall of material, as face. 3. A succession or series of processes, operations, or units. 4. *Elect.* A series of components or networks the output of each of which serves as the input for the next. —*intr.* & *tr. v.* -*cad-ed*, -*cad-ing*, -*cad-ades*. To fall or cause to fall from one level to another in a continuous series. [Fr. < Ital. *cascatia* < *cascare*, to fall < VLat. **casicare* < Lat. *cadere*.]

cas-cara (kä-skär'ë) *n.* 1. The cascara buckthorn. 2. Cascara sagrada. [Sp. *cascara*, bark < *cascar*, to break < VLat. **quassicare* < Lat. *quassare* < *quatore*, to shake.]

cascara buckthorn *n.* A shrub or tree, *Rhamnus purshiana*, of northwestern North America, whose bark is the source of cascara sagrada.

cascara sa-gra-da (sä-grä'dä) *n.* The dried bark of the cas-

ara buckthorn, used as a stimulant, cathartic, and laxative. [Am. Sp. *cáscara sagrada* : Sp. *cáscara*, bark + Sp. *sagrada*, sacred.]

cas-carilla (käskär'ë-lä) *n.* 1. A shrub, *Croton eluteria*, of the West Indies, having bitter, aromatic bark. 2. Also *cascarilla bark*. The bark of the cascara, used as a tonic. [Sp. dim. of *cáscara*, bark. —see CASCARA.]

cascarilla oil *n.* An oil obtained from cascara bark that is used as a flavoring.

case¹ (käs) *n.* 1. An instance or example of the existence or occurrence of something. 2. *a.* An occurrence of disease or disorder. *b.* A client, as of a physician or attorney. 3. A set of circumstances or state of affairs; situation. 4. A set of reasons, arguments, or supporting facts offered in justification of a statement, action, situation, or thing. 5. A question or problem; matter: *a case of honor*. 6. A situation that requires investigation, esp. by a formal or official body.

7. *Law.* *a.* An action or suit or just grounds for an action. *b.* The facts or evidence offered in support of a claim. 8. *Informal.* A peculiar or eccentric person. 9. *Ling.* *a.* The syntactic relationship of a noun, pronoun, or adjective to the other words of a sentence, indicated in inflected languages by the assumption of declensional endings and in noninflected languages by the position of the words within the sentence. *b.* The form or position of a word that indicates this relationship. *c.* Such forms, positions, or relationships collectively. 10. *a.* *Ling.* A pattern of inflection of nouns, pronouns, and adjectives to express different syntactic functions in a sentence. *b.* The form of such an inflected word. —*tr. v.* *cased*, *cas-ing*, *cas-es*. *Slang.* To examine carefully, as in planning a crime: *case the bank before robbing it*. —*idiom.* *in any case.* Regardless of what occurred or will occur in case. If it happens that; if. [ME *cas* < OFr. < Lat. *casus* < p.part. of *cadere*, to fall.]

case² (käs) *n.* 1. A container or receptacle. 2. A decorative or protective covering or cover. 3. A box with its contents. 4. A set or pair, as of pistols. 5. The frame or framework of a window, door, or stairway. 6. *Printing.* A shallow, compartmented tray for storing type or type matrices. —*tr. v.* *cased*, *cas-ing*, *cas-es*. To put into, cover, or protect with a case. [ME < Norman Fr. *casse* < Lat. *capsa*.]

case-ate (kä'sé-ät') *intr. v.* -*ated*, -*at-ing*, -*ates*. To undergo caseation. [< Lat. *caseus*, cheese.]

case-ation (kä'sé-ä'shən) *n.* The necrotic degeneration of bodily tissue into a cheeselike substance. [< CASEATE.]

case-book (kä'séök') *n.* A book containing source materials in a specific area, used as a reference and in teaching.

case-harden (käshär'dn) *tr. v.* -*ened*, -*en-ing*, -*ens*. 1. To harden the surface of (iron or steel) by high-temperature shallow infusion of carbon followed by quenching. 2. To make callous or insensitive.

case history *n.* An organized set of facts relevant to the development of an individual or group condition under study or treatment, esp. in sociology, psychiatry, or medicine.

casein (kä'sén, kä'sé-in) *n.* A white, tasteless, odorless milk and cheese protein, used to make plastics, adhesives, paints, and foods. [Ult. < Lat. *caseus*, cheese.]

case knife *n.* A knife kept in a sheath or case. 2. A table knife.

case law *n.* Law based on judicial decision and precedent rather than statute.

case load *n.* The number of cases handled in a given period, as by a clinic or social services agency.

case-mate (käshmät') *n.* 1. A fortified enclosure for artillery on a warship. 2. An armored compartment for artillery on a rampart. [OFr. < Oltal. *casamata*.] —*case'mat-ed* *adj.*

case-mont (käshmänt') *n.* 1. *a.* A window sash that opens outward by means of hinges. *b.* A window with such sashes. 2. A case or covering. [ME < Med. Lat. *casamentum* < *cas* dwelling < Lat. *casus*.] —*case'ment-ed* *adj.*

case-ous (kä'sé-ös) *adj.* Resembling cheese. [< Lat. *caseus*, cheese.]

casern also **caserne** (käzärn') *n.* A military barracks. [Fr. *caserne*.]

case shot *n.* 1. *a.* A canister (sense 2). *b.* The shot in a canister. 2. A shrapnel shell.

case study *n.* A detailed analysis of an individual or group, esp. as an exemplary model of medical, psychological, or social phenomena.

case system *n.* A method of teaching law that emphasizes the study of selected cases rather than the systematic study of legal textbooks.

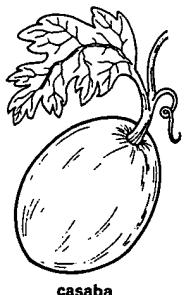
case-work (käshwürk') *n.* The part of a social worker's duties dealing with the problems of a particular case. —*case-work'er* *n.*

cash¹ (käsh) *n.* 1. Ready money; currency or coins. 2. Payment for goods or services in money or by check. —*tr. v.* *cashed*, *cash-ing*, *cash-es*. To exchange for or convert into ready money: *cash a check*. —*phrasal verb.* *cash in*. 1. To withdraw from a venture by or as if by settling one's account. 2. *Slang.* To die. —*idiom.* *cash in on.* To take advantage of. [OFr. *casse*, money box < Lat. *capsa*, case.]

cash² (käsh) *n.*, *pl.* *cash*. Any of various Oriental coins of small denomination, esp. a copper and lead coin with a



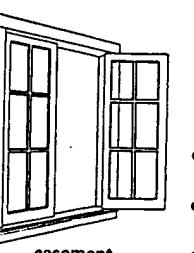
cartwheel



casaba



cascade



casement